

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Eric C. Anderson
Serial No. 09/213,131
Filed: 12/15/1998

Examiner: Yogesh K. Aggarwal
Art Unit: 2622

For: **METHOD AND APPARATUS FOR CORRECTING ASPECT RATIO IN A
CAMERA GRAPHICAL USER INTERFACE**

Mail Stop Appeal Brief – Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

An **APPEAL BRIEF** is filed herewith. The Appellant encloses a payment in the amount of \$540.00 as required by 37 C.F.R. § 41.20(b)(2). If any additional fees are required in association with this appeal brief, the Director is hereby authorized to charge them to Deposit Account 50-1732, and consider this a petition therefor.

APPEAL BRIEF

(1) REAL PARTY IN INTEREST

The present application is owned by Flashpoint Technology, Inc. whose corporate headquarters are 1130 Situs Court, Suite 216, Raleigh, NC 27606.

(2) RELATED APPEALS AND INTERFERENCES

This Appeal Brief is related to a Notice of Appeal filed on March 6, 2006 and an Appeal Brief filed on May 8, 2006. This Appeal Brief is also related to an Examiner's Answer mailed on July 31, 2006 and a Reply Brief filed in response to the Examiner's Answer on October 2, 2006. A further Examiner's Answer was mailed on April 18, 2008 that is also related to this Appeal Brief. However, a Reply Brief was not filed in response to the Examiner's Answer mailed on April 18, 2008. This Appeal Brief is also related to Appeal 2008-6299. Moreover, this Appeal Brief is related to a Decision on Appeal decided on March 9, 2009 affirming the Examiner's rejection that was appealed in the Notice of Appeal filed on March 6, 2006 and the Appeal Brief filed on May 8, 2006. In response to the Decision on Appeal, a Request for Continued Examination (RCE) was filed on May 8, 2009. A non-final Office Action was subsequently issued by the Patent Office on July 22, 2009, to which the Appellant filed a

response on October 21, 2009. The Patent Office then issued a Final Office Action on February 2, 2010, to which the Appellant filed a response on March 30, 2010. An Advisory Action was mailed on April 16, 2010, and the Appellant filed a Notice of Appeal on April 30, 2010.

(3) STATUS OF CLAIMS

Claims 1-6, 10, 19, and 23-27 were cancelled.

Claims 7-9, 11-18, and 20-22 were rejected with the rejection made final on February 2, 2010.

Claims 7-9, 11-18, and 20-22 are pending and are the subject of this appeal.

(4) STATUS OF AMENDMENTS

All amendments have been entered to the best of the Appellant's knowledge. In particular, the Appellant filed an amendment on April 26, 2004, cancelling claims 1-6 and 23-27 and amending claims 7-9 and 13-15, which was subsequently entered, as noted in the Final Office Action mailed on July 12, 2004. The Appellant then filed another amendment on September 29, 2004, cancelling claims 10 and 19 and amending claims 7, 11, 15, and 20, which was entered by way of a RCE filed on January 12, 2005, to which the Patent Office issued an Office Action having a mailing date of March 28, 2005. In response to the Office Action mailed on March 28, 2005, the Appellant filed an amendment amending claims 7 and 15 on June 28, 2005, which was subsequently entered as noted in the Final Office Action mailed on September 22, 2005. Subsequent to the Final Office Action mailed on September 22, 2005, the Appellant filed a response amending claims 7-9, 13, and 14 on November 21, 2005. The amendment was then entered and a Final Office Action was mailed on December 5, 2005. A response to the Final Office Action mailed on December 5, 2005 amending the Specification and claim 12 was filed on February 6, 2006. These amendments were entered as noted in the Advisory Action mailed on February 21, 2006. After issuance of the Decision on Appeal decided on March 9, 2009, the Appellant filed a RCE amending claims 7, 13-17, and 20-22 on May 8, 2009, which was entered as noted in the Office Action mailed on July 22, 2009. Thus, to the best of the Appellant's knowledge, all amendments have been entered.

(5) SUMMARY OF CLAIMED SUBJECT MATTER

In the following summary, the Appellant has noted where in the Specification certain subject matter exists. The Appellant wishes to point out that these citations are for demonstrative purposes only and that the Specification may include additional discussion of the various elements, citations to which are not pointed out below. Thus, the noted citations are in no way intended to limit the scope of the pending claims.

Independent claim 7 recites a method for correcting an aspect ratio of an image captured by an image capture device (see Figure 2, element 110; see also Specification, page 7, ll. 5-18) comprising the steps of:

rotating the image, if required, so that the image appears upright on a display (see Figure 4, element 402; see also Specification, page 9, lines 1-3) of the image capture device (see Specification, page 23, lines 3 - 6 and page 25, line 22 – page 26, line 5);

determining if the aspect ratio of the image matches a predetermined aspect ratio (see Figure 12, step 912; see also Specification, page 26, lines 11-14);

decompressing the image if required (see Figure 12, step 914; see also Specification, page 26, lines 14-16);

cropping the image if the aspect ratio does not match the predetermined aspect ratio, thereby providing a cropped image (see Figure 12, steps 916 and 918; see also Specification, page 26, line 17 – page 27, line 1); and

providing the cropped image to the display (see Figure 12, step 920; see also Specification, page 27, lines 1-2);

wherein the image capture device is not a scanner (see Figures 2-10; see also Specification, page 7, line 5 – page 24, line 1).

Independent claim 15 recites a system for correcting an aspect ratio of an image captured by an image capture unit (see Figure 2, element 110; see also Specification, page 7, ll. 5-18) comprising:

means for rotating the image (see Figure 4, element 344, and Figure 7 (background spooling process 618, and specifically image processing and compression process 622, said processes implemented as background processes on element 344) Figure 8, elements 550 and 556 and Figure 9, steps 1013 – 1026; see also Specification, page 8, lines 21-23, page 16, line 14 – page 17, line 8, page 18, lines 20-22, page 20, line 12 – page 22, line 9, and page 23, lines 3-6 and 19-22), if

required, so that the image appears upright on a display (see Figure 4, element 402; see also Specification, page 9, lines 1-3) of the image capture device (see Specification, page 23, lines 3 - 6 and page 25, line 22 – page 26, line 5);

means (see Figure 4, element 344 and Figure 7 (conversion and compression process 614, which may be implemented as a process on element 344); see also Specification, page 8, lines 21-23), coupled with the image rotating means, for determining if the image requires cropping (see Figure 12, step 912; see also Specification, page 26, lines 11-14);

means (see Figure 4, element 344 and Figure 7 (conversion and resizing process 616, which may be implemented as a process on element 344); see also Specification, page 8, lines 21-23) coupled to the determining means for decompressing the image if required (see Figure 12, step 914; see also Specification, page 26, lines 14-16);

means (see Figure 4, element 344 and Figure 7 (conversion and resizing process 616, which may be implemented as a process on element 344); see also Specification, page 8, lines 21-23) coupled to the decompressing means for cropping the image if the image requires cropping, thereby providing a cropped image (see Figure 12, steps 916 and 918; see also Specification, page 26, line 17 – page 27, line 1); and

means (see Figure 4, element 344 and Figure 7 (live generation process 612, which may be implemented as a process on elements 344, 538, and 402); see also Specification, page 8, lines 21-23) coupled to the cropping means for providing the cropped image to the display (see Figure 12, step 920; see also Specification, page 27, lines 1-2);

wherein the image capture unit is not a scanner (see Figures 2-10; see also Specification, page 7, line 5 – page 24, line 1).

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 7-9, 11-18, and 20-22 were properly rejected under 35 U.S.C. § 112, first paragraph.

(7) ARGUMENT

A. Introduction

All of the pending claims comply with the written description requirement under 35 U.S.C. § 112, first paragraph. The Appellant submits that the Patent Office has not established

how the pending claims do not comply with the written description requirement under 35 U.S.C. § 112, first paragraph in order to maintain the rejection. Therefore, the Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims for these reasons along with the reasons noted below.

B. Legal Standards

1. Compliance With The Written Description Requirement

As the Courts have held, an objective standard for determining compliance with the written description requirement is, “does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed.”¹ As the Federal Circuit held in *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991), in order to satisfy the written description requirement, an Applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed. The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon “reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.”² Moreover, while there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure. An amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of the error in the specification, but also recognize the appropriate correction.³

C. Claims 7-9, 11-18, and 20-22 Are Patentable Under 35 U.S.C. § 112, First Paragraph

Claims 7-9, 11-18, and 20-22 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Patent Office opined that the claims have subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time

¹ *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989).

² *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)).

³ *In re Oda*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971).

the application was filed, had possession of the claimed invention. The Appellant respectfully traverses the rejection.

The Appellant submits that the claims comply with 35 U.S.C. § 112, first paragraph. According to Chapter 2163 of the M.P.E.P., while “there is no in haec verba requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure.” In addition, as the Court of Appeals for the Federal Circuit has recently held, “the failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented.”⁴ The Appellant submits that the feature of an image capture device not being a scanner is both implicit and inherent in the Specification as originally filed. The Specification discusses a digital camera 110, the various components of the digital camera 110, and the operation of the digital camera 110. The Appellant submits that as the Specification and the Figures disclose a digital camera, it is inherent that an image capture device is not a scanner. More specifically, as the Specification explicitly discloses a digital camera 110, it necessarily flows that the image capture device cannot be a scanner. The Appellant also submits that, as the Specification and the Figures disclose a digital camera, it is implicit that an image capture device is not a scanner. In particular, as the Specification explicitly discloses a digital camera 110, one skilled in the art would reasonably infer that the image capture device is not a scanner. Thus, the Specification clearly allows one skilled in the art to recognize that the Appellant invented what is claimed, i.e., that the image capture device is not a scanner.

The Patent Office responds to this line of reasoning by first indicating that a scanner and a digital camera are the same thing.⁵ Then, the Patent Office goes on to state that “the applicant clearly did not want[ed] anything other than a camera.”⁶ Furthermore, the Patent Office attempts to glean the intent of the inventor in the application by stating that there “is no intent on the part of the applicant in their Specification which shows to one skilled in the art that the invention could have been implemented anywhere other than a camera.”⁷ To summarize, the Patent Office

⁴ See All Dental Prodx LLC v. Advantage Dental Prods., 309 F.3d 774 at 779 (Fed. Cir. 2002) (citing Eiselstein v. Frank 52 F.3d 1035, 1039 (Fed. Cir. 1995)).

⁵ See Final Office Action mailed February 2, 2010, pages 3-5, BPAI Decision on Appeal decided on March 9, 2009, page 6, and Advisory Action mailed April 16, 2010, page 3.

⁶ See Advisory Action mailed April 16, 2010, page 3.

⁷ See Advisory Action mailed April 16, 2010, page 4.

has concluded the following: that a scanner and a digital camera are the same thing, that the Appellant did not want anything other than a camera, and that the Specification does not indicate that the Appellant intended to exclude other devices, such as a scanner. The Appellant submits that if the Patent Office and the BPAI have indicated that a scanner and a digital camera are the same thing and if the Patent Office can conclude on its own that, based on the specification, the Appellant clearly only wanted a digital camera, then, contrary to what is asserted by the Patent Office, it follows that one skilled in the art could conclude that the inventor intended to exclude a scanner. Thus, the feature of an image capture device not being a scanner is both implicit and inherent in the Specification as originally filed.

The Patent Office also states that there “is nothing wrong with claiming a negative limitation as long as the specification teaches one skilled in the art something explicitly or implicitly.”⁸ The Appellant submits that, using the interpretation of both the Patent Office and the BPAI that a scanner and a digital camera are the same and, to quote the Patent Office, the Appellant “clearly did not want[ed] anything other than a camera,” one skilled in the art would reasonably conclude that that the feature of an image capture device not being a scanner is implicit in the Specification as originally filed. Stated another way, if a camera and scanner are the same thing and, as mentioned by the Patent Office, the Appellant only wanted a digital camera, then the feature of an image capture device not being a scanner is implicit. Thus, as correctly pointed out by the Patent Office, the Appellant is entitled to claim that an image capture device is not a scanner.

Furthermore, the Patent Office pointed out that if “alternative elements are positively recited in the specification, they may be explicitly excluded in the claims.”⁹ Throughout the originally filed application, such as Figures 2-10 and the accompanying description, discussion is made regarding the digital camera 110, the various components of the digital camera 110, and the operation of the digital camera 110, which both the Examiner and the BPAI has equated with a scanner.¹⁰ In particular, the Patent Office states that the “prior art teaches a scanner which the BPAI has clearly said [that it] falls within the broad definition of a digital camera.”¹¹ Therefore, according to the Patent Office, a digital camera is the same thing as a scanner. The Appellant

⁸ See Advisory Action mailed April 16, 2010, page 3.

⁹ See Final Office Action mailed February 2, 2010, page 4.

¹⁰ See Final Office Action mailed February 2, 2010, pages 3-5 and BPAI Decision on Appeal decided on March 9, 2009, page 6.

¹¹ See Advisory Action mailed April 16, 2010, page 3.

submits that as the Specification clearly recites a digital camera, which the Patent Office has equated with a scanner, then the Appellant is entitled to explicitly exclude a scanner in the claims.

In addition, the Appellant submits that the Appellant is entitled to disclaim something that may arguably fall within the broadest reasonable interpretation of the claims. By reciting that the image capture device is not a scanner, the Appellant is merely pointing out that the claim does not cover a scanner in order to avoid an overly broad interpretation of the pending claims when viewed in light of the Specification. For at least this reason and the reasons noted above, claims 7 and 15 comply with the written description requirement under 35 U.S.C. § 112, first paragraph. Likewise, claims 8, 9, 11-14, 16-18, and 20-22, which depend from either claim 7 or claim 15, are patentable for at least the same reasons.

D. Conclusion

As discussed above, all of the pending claims comply with the written description requirement under 35 U.S.C. § 112, first paragraph. The Appellant submits that the Patent Office has not established how the pending claims do not comply with the written description requirement under 35 U.S.C. § 112, first paragraph. As such, the Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims for at least these reasons.

Respectfully submitted,

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(8) CLAIMS APPENDIX

1-6. (Cancelled).

7. A method for correcting an aspect ratio of an image captured by an image capture device comprising the steps of:

rotating the image, if required, so that the image appears upright on a display of the image capture device;

determining if the aspect ratio of the image matches a predetermined aspect ratio;

decompressing the image if required;

cropping the image if the aspect ratio does not match the predetermined aspect ratio, thereby providing a cropped image; and

providing the cropped image to the display;

wherein the image capture device is not a scanner.

8. The method of claim 7 wherein the step of cropping the image further comprises the step of: resizing the image.

9. The method of claim 8 wherein the aspect ratio determining step further comprises the step of:

determining the aspect ratio of the image; and

determining if the aspect ratio of the image matches an aspect ratio of the display.

10. (Cancelled).

11. The method of claim 7 wherein the display is an LCD screen.

12. The method of claim 11 wherein the image is a scrennail image.

13. The method of claim 12 further comprising the step of:

updating the scrennail image with a higher resolution image.

14. The method of claim 13 wherein the step of updating the scrennail image further comprises the step of:

- retrieving the higher resolution image;
- determining if the higher resolution image requires cropping;
- decompressing the higher resolution image;
- cropping the higher resolution image if the higher resolution image requires cropping; and
- providing the higher resolution image to the display.

15. A system for correcting an aspect ratio of an image captured by an image capture unit comprising:

- means for rotating the image, if required, so that the image appears upright on a display of the image capture device;

- means, coupled with the image rotating means, for determining if the image requires cropping;

- means coupled to the determining means for decompressing the image if required;

- means coupled to the decompressing means for cropping the image if the image requires cropping, thereby providing a cropped image; and

- means coupled to the cropping means for providing the cropped image to the display;

- wherein the image capture unit is not a scanner.

16. The system of claim 15 wherein the decompressing means further comprises:

- means for decompressing and resizing the image.

17. The system of claim 16 wherein the determining means further comprises:

- means for determining the aspect ratio of the image; and

- matching means coupled to the aspect ratio determining means for determining if the aspect ratio of the image matches an aspect ratio of the display.

18. The system of claim 17 wherein the display is an LCD screen.

19. (Cancelled).
20. The system of claim 15 wherein the image is a scrennail image.
21. The system of claim 20 further comprising:
means for updating the scrennail image with a higher resolution image.
22. The system of claim 21 wherein the means for updating the scrennail image further comprises:
means for retrieving the higher resolution image;
means coupled to the higher resolution image retrieving means for determining if the higher resolution image requires cropping;
means coupled to the higher resolution image determining means for decompressing the higher resolution image;
means coupled to the higher resolution image decompressing means for cropping the higher resolution image if the higher resolution image requires cropping; and
means coupled to the higher resolution image cropping means for providing the higher resolution image to the display.
- 23-27. (Cancelled).

(9) EVIDENCE APPENDIX

The Appellant relies on no evidence, thus this appendix is not applicable.

(10) RELATED PROCEEDINGS APPENDIX

This Appeal Brief is related to a Notice of Appeal filed on March 6, 2006 and an Appeal Brief filed on May 8, 2006, which are attached as Appendix A.